

REMARKS

Applicants thank the Examiner for the very thorough consideration given the present application. Claims 1-13 are currently pending in this application. None of the claims have been amended. Accordingly, no new matter has been added.

In view of the remarks herein, Applicants respectfully request that the Examiner withdraw all outstanding rejections and allow the currently pending claims.

Specification issues

The Examiner has objected to the Specification because it introduces new matter. Applicants respectfully traverse.

The Examiner asserts that the limitation requiring that the water soluble skin care agent be applied on an entirety of the surface to be contacted with the skin of a wearer of the gather portion is not supported by the originally filed disclosure.

Applicants note that the limitation "the whole surface" was incorporated into claim 1 by way of the amendment of September 29, 2008. Such a limitation was supported by the Specification at, for example, page 24 (where it is disclosed that the water-soluble skin care agent can be applied "on the whole body"). The Examiner did not raise any new matter issues in response to Applicants' amendment of September 29, 2008.

Applicants respectfully submit that the limitation "an entirety of the surface", incorporated into claim 1 by way of the amendment of March 27, 2009, merely recites more clearly the previously presented limitation of "the whole surface," and does not in any way introduce new matter.

Reconsideration and withdrawal of this objection are thus respectfully requested.

Issues Under 35 U.S.C. 112, first paragraph

Claims 1-13 stand rejected under 35 U.S.C. 112, 1st paragraph. Applicants respectfully traverse.

The Examiner asserts that the Specification does not reasonably provide enablement for a water soluble skin care agent being applied on an entirety of the surface to be contacted with the skin of a wearer of the gather portion.

According to MPEP 2164, the fact that an additional limitation to a claim may lack descriptive support in the disclosure as originally filed (a point which Applicants do not concede; see previous section) does not necessarily mean that the limitation is also not enabled. The statement of a new limitation in and of itself may enable one skilled in the art to make and use the claim containing that limitation. The standard for determining whether the specification meets the enablement requirement is: *“is the experimentation needed to practice the invention undue or unreasonable?”*

Applicants submit that one skilled in the art would not need to engage in undue experimentation in order to determine how to apply a water soluble skin care agent on an entirety of a surface to be contacted with the skin of a wearer. Moreover, the Examiner’s attention is directed to paragraph [0052] of the present Specification, which clearly provides enablement for the claimed limitation.

In view of the above, reconsideration and withdrawal of this rejection are thus respectfully requested.

Issues Under 35 U.S.C. § 103(a)

Claims 1-4 and 10-12 stand rejected under 35 U.S.C. §103 (a) as being obvious over Ducker et al. (U.S. 5,938,649) (hereinafter Ducker '649). Claims 5-9 stand rejected as obvious over Ducker '649 in view of Hoshino et al. (U.S. 6,685,953) (hereinafter Hoshino '953) further in view of Ptchelintsev et al. (U.S. 5,834,513) (hereinafter Ptchelintsev '513). Applicants respectfully traverse.

The Examiner asserts that Ducker '649 discloses a diaper comprising a liquid impermeable back outer layer sheet, an absorber fixed on the outer layer sheet and a gather portion having a flexible elastic member formed on a predetermined position. The Examiner further asserts that Ducker '649 teaches the application of a water-soluble skin care agent and an oily skin care agent. Moreover, the Examiner contends that "the manner in which the surfactant and agents are applied to the article is considered as product by process limitations which do not patentably distinguish the claimed invention from the prior art."

The Examiner acknowledges that Ducker '649 does not teach that the water soluble skin care agent is applied on an entirety of the surface to be contacted with the skin of the wearer of the gather portion. However, the Examiner argues that this would have been obvious to one skilled in the art "since the inclusion of such would ensure the agent is available to contact as much of the wearer as possible thereby providing added protection."

Applicants respectfully submit that the Examiner has failed to establish a *prima facie* case of obviousness. To establish a *prima facie* case of obviousness, the Examiner must make the factual determinations set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 17 (1966). "[T]he examiner bears the initial burden, on review of the prior art or on any other ground, of presenting

a *prima facie* case of unpatentability.” *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992). A patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art. *KSR Int’l Co. v Teleflex Inc.*, 82 USPQ 2d 1385 (U.S. 2007). There must be a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does. *Id.* The Supreme Court of the United States has recently held that the “teaching, suggestion, motivation test” is a valid test for obviousness, albeit one which cannot be too rigidly applied. *Id.* “[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *Id.* (quoting *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006)).

The present invention is directed, *inter alia*, to an absorbent article wherein a water-soluble skin care agent and an oily skin care agent are applied on a surface of the article. In the absorbent article of the present invention, the oily skin care agent is applied on a predetermined region on which a water-soluble skin care agent is applied. The water-soluble skin care agent is applied on an **entirety of the surface** to be contacted with the skin of the wearer of the gather portion (emphasis added). Further, the oily skin care agent is applied directly **on the water-soluble skin care agent** (without the need for auxiliary agents), so that at least a portion of the oily skin care agent is transferred to the skin of the wearer before the water-soluble skin care agent is transferred (emphasis added).

Applicants respectfully submit that Ducker ‘649 fails to teach or suggest an absorbent article as presently claimed. Ducker ‘649 specifically discloses that aloe vera is used in combination with a lubricant. Moreover, Ducker ‘649 further discloses that, in order to alleviate

spoilage concerns, the aloe vera is mixed with a relatively waterless lubricant (see, e.g., col. 5, lines 37-42; see also col. 7, lines 8-11).

Clearly, Ducker '649 discloses that the oily skin care agent and the water-soluble skin care agent are mixed or blended together. Thus, Ducker '649 cannot possibly disclose an absorbent article wherein a water-soluble skin care agent is applied on an **entirety of the surface** to be contacted with the skin of a wearer of the gather portion and an oily skin care agent is applied **directly on the water-soluble skin care agent** (emphasis added). The secondary references cited by the Examiner fail to cure these deficiencies.

Hoshino '953 is directed to external preparation compositions comprising a diamide derivative. Hoshino '953 does not disclose the addition of this derivative to absorbent articles, or the combination of this composition with a water-soluble skin care agent.

Ptchelintsev '513 is directed to compounds used for treating skin conditions. Ptchelintsev '513 does not disclose the addition of these compounds to absorbent articles, or the combination of these compounds with a water-soluble skin care agent.

Clearly, the cited references fail to teach or suggest each and every limitation of the present invention. For this reason alone, this rejection is improper and should be withdrawn. Moreover, Applicants submit that one skilled in the art would not have been motivated to modify the absorbent article of Ducker '649 as proposed by the Examiner.

At col. 4, lines 5-9, Ducker '649 discloses:

"Another consideration related to the present product concerns spoilage. Once aloe vera in a water based solution is exposed to the environment, the aloe vera begins to decompose and lose its effectiveness."

Ducker '649 proposes how to overcome spoilage concerns at col. 5, lines 29-37, where it is disclosed:

“A particularly preferred means of controlling spoilage is incorporating aloe vera, and particularly a highly concentrated aloe vera, into a relatively waterless solution. For purposes of the present invention, the term solution encompasses blends, combinations, admixtures, suspensions, homogeneous mixtures, heterogeneous mixtures and solutions. Preferably, the other constituent of the solution is a lubricant. Most preferred, the lubricant is petrolatum.”

Clearly, Ducker '649 **teaches away** from the present invention, as it explicitly discloses that the use of a **waterless** solution is necessary in order to avoid undesirable spoilage (which causes aloe vera to lose its efficacy) (emphasis added).

In view of the above, reconsideration and withdrawal of this rejection are respectfully requested.

Miscellaneous

Applicants note that claim 13 does not stand rejected based on prior art. As such, Applicants submit that this claim is allowable.

Moreover, in view of the remarks herein, Applicants submit that all presently pending claims are in condition for allowance.

A Notice of Allowability is respectfully requested.

Conclusion

All of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully request that the Examiner reconsider all presently outstanding rejections and objections and that they be withdrawn. It is believed that a full and complete response has been made to the outstanding Office Action and, as such, the present application is in condition for allowance.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Vanessa Perez-Ramos, Reg. No. 61,158, at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37.C.F.R. §§1.16 or 1.147; particularly, extension of time fees.

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Respectfully submitted,

By



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